REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application.

Claims 1-3 are pending in the application. Applicant has amended claim 1.

I. Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,349 to Sanpei et al. ("Sanpei") in view of U.S. Patent No. 6,658,496 to Minakata et al. ("Minakata").

Applicant has amended claim 1 to more particularly point out and distinctly claim the subject matter regarded as the invention. In particular, claim 1 has been amended to recite that the reproducing unit has a first memory for endless-recording before being switched by the switching unit where the "second memory endless-records the current conversation simultaneously with the reproducing of the conversation content from said first memory." The present invention, as recited in amended claim 1 is directed to a portable phone having a recording function for recording audio data during a telephone conversation. A plurality of memories is featured with each of the memories configured for endless-recording of conversation content, with a switching unit capable of switching memories between the plurality of memories so that, if a user chooses, playback of the recorded content can occur before the end of the recording. Importantly, one memory can playback the recorded content while a second memory continues to endless record.

A user of a portable phone may sometimes find it necessary to replay or reproduce a conversation previously recorded by a mobile telephone. Such a situation may arise when the user wishes to replay a portion of an earlier conversation for the benefit of the party on the line while a current conversation is being recorded. According to an aspect of Applicant's claimed invention, more than one memory (or more than one memory areas of a single memory device) are provided so that while conversation contents previously recorded on a first memory are being reproduced, a second memory can record conversation data of the current conversation. A switching unit is provided so that the first memory dedicated to recording the conversation is switched to a second memory so that playback of the recorded conversation can occur in the first memory. Simultaneous with the playback of the first memory, a second memory can continue to endless record so that there are no pauses in the endless recording. Such a capability is absent in both of the cited references.

The base reference, Sanpei, is directed to a portable telephone with audio recording capability. As the Examiner admits, Sanpei does not teach a plurality of memories or a switching unit capable of switching memories for endless recording of audio data.

Minakata does not overcome the shortcomings of the Sanpei reference. Minakata is directed to a recording apparatus with multiple memories. Although Minakata does teach a switching unit, the switching unit is not capable of endless-recording with a first memory while the second memory reproduces the audio content. For example, Minakata states:

> The recording unit 10 is in operation beginning when a recording start button, not shown, of the actuating unit 50, is pressed, until a stop button, not shown, is pressed. During this time, speech data corresponding to the output speech signals of the microphone 11 is recorded as a task file in the flash memory 9. If, for example, the second flash memory 9b is not loaded on the IC recorder 1, the speech data is stored in the first flash memory 9a. If the second flash memory 9b is loaded on the IC recorder 1 and the first flash memory 9a is

> charged to its full capacity, the speech data is written in the second flash memory 9b.
>
> The first flash memory 9a is enclosed in the IC recorder 1, while the second flash memory 9b can be attached to the IC recorder 1 and is connected to the controller 30 via connector 8. It can be optionally determined whether speech data is to be written with priority in the first flash memory 9a or in the second flash memory 9b. Alternatively, a changeover button may be provided in the actuating unit 50 to permit the user to select in which of the first or second flash memories 9a or 9b the speech data is to be stored. Minakata column 3 lines 31-51.

The actuating unit of Minakata simply switches between flash memory upon user activation. There is no simultaneous playback of audio content from one memory while continuous recording takes place at the other memory. Therefore, Minakata does not teach a switching unit where the "second memory endless-records the current conversation simultaneously with the reproducing of the conversation content from said first memory" as is required by claim 1.

Therefore, Applicant respectfully submits that a combination of Sanpei and Minakata does not teach or suggest every claimed feature of the invention. The prior art reference (or references) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Since a *prima facie* case of obviousness has not been set forth, Applicant respectfully submits that claim 1 is allowable over the cited references. Claims 2 and 3, which depend from claim 1, are similarly allowable.

II. Conclusion

For the foregoing reasons, Applicant respectfully submits that all pending claims 1-3 are now in condition for allowance. Early notice to that effect is earnestly solicited.

Respectfully submitted,

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